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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,346	04/09/1999	LINDA HANLEY-BOWDOIN	5051-458	8481
20792	7590	12/30/2003	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC			HELMER, GEORGIA L	
PO BOX 37428			ART UNIT	
RALEIGH, NC 27627			PAPER NUMBER	
			1638	

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/289,346

Applicant(s)

HANLEY-BOWDOIN ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 87 is/are allowed.
- 6) ☒ Claim(s) 88-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. The Office acknowledges receipt of Applicants Response; dated 6 October 2003, and acknowledges receipt of the 1.132 Declaration of Linda Hanley-Bowdoin dated 3 October 2003.
2. Applicant has cancelled claims 60-86. New claims 87-90 have been added. Methods claims 89 and 90 have been rejoined in accordance with *In re Ochiai* with product claims. Claims 87-90 are pending and are examined in this Office Action.
3. This action is made FINAL necessitated by Applicant's amendment.
4. All rejections not addressed below have been withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112 second

6. Claim 88 is drawn to a nucleic acid of claim 60, a claim which has been cancelled. The Office assumes this to be an error, and in order to further prosecution, assumes that claim 88 is dependent on claim 87. Applicant needs to correct the claim dependency in order to be fully responsive to this Office Action.

The following rejections are made to new claims 89 and 90.

7. In claim 88 (line 6), said nucleic acid encoding a “mutant AL1 protein” lacks antecedent basis, and is rejected under 35 USC 112.2.

Claim Rejections - 35 USC § 112 first paragraph-Enablement

8. Claims 89 and 90 are rejected under 35 U.S.C. 112, first paragraph, because the method of making a transgenic plant having increased resistance to geminivirus by ..expression of a nucleic acid...increases resistance to infection by geminivirus, is not enabled.

- The issue is “increased resistance”. Applicant claims method of making a transgenic plant having increased resistance to geminivirus by ..expression of a nucleic acid...increases resistance to geminivirus. However, Applicant does not teach any specific level of expression of the nucleic acid sequence. Disease resistance is a complex physiological process of the plant is response to the pathogen. Requirements for this process are that (i) the appropriate nucleic acid sequence(s) be expressed, and (ii) that the appropriate quantity of the nucleic acid sequence expressed, in order to function as desired in produce the increased resistance phenotype. While one skilled in the art can readily produce

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transgenic plants which heterologous DNA, it is unpredictable what level of expression will result in the desired disease resistance phenotype. Applicant has provided no guidance on how to predictably eliminate inoperable embodiments from a virtually ad infinitum of possibilities other than by random trial and error, which is excessive experimentation and an undue burden.

The Declaration of Linda Hanley-Bowdoin.

9. The Declaration of Linda Hanley-Bowdoin has been carefully considered and is persuasive with respect to typographical errors in the DNA sequence of certain mutants in Table 4 of the specification. Corrected Table 4 has been entered.

Remarks

10. Claim 87 is allowed. Sequences SEQ ID NO: No 2-10 are free of the prior art of record.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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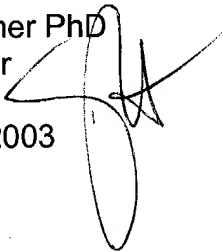
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00. *Note that Examiner's phone number will change to 571-272-0796 as of 6 January 2004.*

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer PhD
Patent Examiner
Art Unit 1638
December 24, 2003




PHUONG T. BUI
PRIMARY EXAMINER 12/24/03